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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,993	08/15/2005	Karel Dolezal	J507-005 US	8995
21706 7590 01/26/2011 NOTARO, MICHALOS & ZACCARIA P.C. 100 DUTCH HILL ROAD ORANGEBURG, NY 10962				
EXAMINER MCINTOSH III, TRAVIS C				
ART UNIT 1623		PAPER NUMBER		
MAIL DATE 01/26/2011		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,993

Applicant(s)

DOLEZAL ET AL.

Examiner

TRAVISS C. MCINTOSH III

Art Unit

1623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 15-17 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Amendment filed 1/10/2011 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claim 2 has been amended.

Claims 1, 3-14, and 18-21 are canceled.

Claim 22 stands as being withdrawn.

Remarks drawn to rejections of Office Action mailed November 15, 2010 include:

102(b) rejection: which has been overcome by applicant's amendments and has been withdrawn.

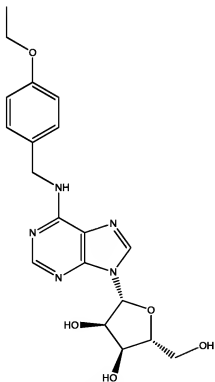
103(a) rejection: which has been overcome by applicant's amendments and has been withdrawn.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/10/2011 has been entered.

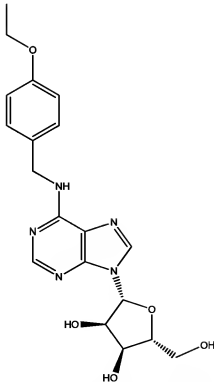
An action on the merits of claims 2 and 15-17 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

Claim Objections

Claim 2 is objected to because of the following informalities: the claim contains the same compound listed 2 times. The compound bridging lines 13-14 of claim 2 as it was submitted on 1/10/11 provides for "6-(4-ethoxybenzylamino)purine riboside" and the compound bridging lines 18-19 provides for "6-(4-ethoxybenzylamino)purine riboside", which appears to be the same structure as seen below:



6-(4-ethoxybenzylamino)purine riboside



6-(4-ethoxybenzylamino)purine riboside

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Golisade et al. ("Anti-Malarial Activity of N6-Substituted Adenosine Derivatives", Bioorganic and Medicinal Chemistry, vol. 10, March 2002, pp. 769-777).

Golisade discloses N⁶-[(4-phenyl)benzyl]adenosine as compound 16e on the bottom of page 774, and also in Scheme 4. Likewise, Table 1 discloses compositions comprising the same and discusses the anti-malarial activity of the compound. The intended use is not seen to make patentable the compositions claims as the prior art's compositions could have functioned in the same way as the instant compositions, as they contain the same claimed amount of the same claimed agents, and thus are seen to be the same. While the examiner has made an effort to indicate all of the species which are contained in the reference and anticipate the instant claims, it is noted that "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus of the instant claims. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). As such, applicants are encouraged to review

the document in it's entirety to remove all species in their claims which are disclosed in the reference.

Conclusion

The examiner would like to note that the following species are deemed allowable:

6-(2-acetylbenzylamino)purine riboside;
6-(3-acetylbenzylamino)purine riboside;
6-(4-acetylbenzylamino)purine riboside;
6-(2-acetoxybenzylamino)purine riboside;
6-(3-acetoxybenzylamino)purine riboside;
6-(4-acetoxybenzylamino)purine riboside;
6-(2-sulphobenzylamino)purine riboside;
6-(3-sulphobenzylamino)purine riboside;
6-(4-sulphobenzylamino)purine riboside;
6-(4-sulphobenzylamino)purine riboside;
6-(4-methylaminobenzylamino)purine riboside;
6-(4-hexylbenzylamino)purine riboside;
6-(4-hexyloxybenzylamino)purine riboside;
6-(2-formylbenzylamino)purine riboside;
6-(3-formylbenzylamino)purine riboside;
6-(4-formylbenzylamino)purine riboside;
6-(2-ethoxybenzylamino)purine riboside;

6-(3-ethoxybenzylamino)purine riboside;
6-(4-ethoxybenzylamino)purine riboside (which is seen to be the same as 6-(4-ethyloxybenzylamino)purine riboside as noted above);
6-(4-ethylbenzylamino)purine riboside;
6-(4-pentylbenzylamino)purine riboside;
6-(4-pentyloxybenzylamino)purine riboside;
6-(4-phenoxybenzylamino)purine riboside;
6-(4-propylbenzylamino)purine riboside;
6-(4-propyloxybenzylamino)purine riboside;
6-(4-octylbenzylamino)purine riboside; and
6-(4-octyloxybenzylamino)purine riboside.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/
Primary Examiner, Art Unit 1623
January 18, 2011